



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,496	12/07/2000	Anthony J. Durkin	CDL-031	1265

21323 7590 04/21/2003

TESTA, HURWITZ & THIBEAULT, LLP  
HIGH STREET TOWER  
125 HIGH STREET  
BOSTON, MA 02110

EXAMINER

DAHBOUR, FADI H

ART UNIT	PAPER NUMBER
----------	--------------

3742

10

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/731,496

Applicant(s)

DURKIN ET AL.

Examiner

Fadi H. Dahbour

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. The Examiner acknowledges Applicant's submission of the amendment filed on 4/8/03. Claims 1-34 are now pending.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15, 17-30, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neev ('739) in view of Anderson et al ('801).

Neev discloses a method of treating acne in a preselected region of mammalian skin having at least one acne lesion disposed therein (Figs.1-10) wherein the pre-selected region is dermal region (see "in another preferred embodiment...the dermis" in lines 32-33 of col.8), comprising cooling an area of the skin above the preselected dermal region (42 of Fig.1), and exposing the preselected dermal region to a beam of radiation comprising a wavelength in the range from about 0.6 microns to about 1.8 microns to ameliorate the lesion (see "laser... wavelength...from 300 nanometers to 2 microns" in lines 60 & 63 & 65 of col.8), while keeping the temperature of the area of the skin above the preselected dermal region cooled before, during, or before and during the application of the energy (42 of Fig.1, also see "cooled, preceding and/or following application of the energy thereto" in lines 16-18 of col.3), wherein the wavelength is in

the range from about 1.2 to about 1.7 microns (see "from 300 nanometers to 2 microns" in line 65 of col.8), wherein the wavelength is in the range from about 1.3 to about 1.6 microns (see "from 300 nanometers to 2 microns" in line 65 of col.8), wherein the wavelength is about 1.5 microns (see "from 300 nanometers to 2 microns" in line 65 of col.8), wherein the beam of radiation has a power density in the range from about 1 to about 10,000 watts per square centimeter (see lines 1-8 of col.9), wherein the power density is in the range from about 5 to about 5,000 watts per square centimeter (see lines 1-8 of col.9), wherein the beam of radiation has a fluence in the range from about 5 to about 500 joules per square centimeter (see lines 1-8 of col.9), wherein the fluence is in the range from about 10 to about 150 joules per square centimeter (see lines 1-8 of col.9), wherein step-a occurs prior to step-b (see "cooled, preceding and/or following" in lines 16-17 of col.3), wherein step-a occurs contemporaneously with step-b (see "cooling...during" in lines 25-26 of col.10), further comprising the additional step of prior to step-b providing a radiation absorbing material to the preselected dermal region (see "absorption substance...prior to" in line 67 of col.3, and line 1 of col.4), wherein applying energy in step-b reduces the size of a lesion disposed within the preselected dermal region (see "to decrease the size of a skin lesion" in line 66 of col.4), wherein applying energy in step-b reduces the density of lesions disposed within the preselected region (see "removal of skin lesions" in lines 23-24 of col.18), wherein applying energy in step-b reduces lesion-associated skin-inflammation in the preselected dermal region (see "to decrease the size of a skin lesion" in line 66 of col.4, also see "removal of skin lesions" in lines 23-24 of col.18), wherein in step-b the energy is provided by a laser light,

incoherent light, microwaves, ultrasound or RF current (see "laser" in line 60 of col.8), wherein in step-b the energy is provided by laser light (see "laser" in line 60 of col.8).

Neev lacks the cooling temperature being below about 60° C. Anderson discloses a cooling temperature being below about 60° C (see "preferably cools the area of the skin above the targeted dermal region to temperatures below approximately 50 to 70 degrees Celsius during application of the radiation" in lines 48-51 of col.5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the feature taught by Anderson, in the device of Neev, because Anderson teaches that it is "so as not to cause collateral thermal damage to the epidermis" (see lines 51-52 of col.5 of Anderson), and also because Neev teaches that "U.S. Pat. 5,810,801 to Anderson et al, which is also incorporated herein by reference" (see lines 47-48 of col.1 of Neev).

4. Claims 16, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neev ('739) in view of Anderson et al ('801), and the admitted prior art.

Neev and Anderson further disclose the disorder being acne (see "acne" in lines 63-64 of col.3 of Neev). Neev and Anderson lack the disorder being acne vulgaris. The admitted prior art discloses acne vulgaris (see "acne vulgaris" in line 7 of page 2 of Applicant's specification). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the feature taught by the admitted prior art, in the method of Neev and Anderson, because the admitted prior art teaches that it is known that acne vulgaris is form of acne (see "acne vulgaris is...form of acne" in lines 7-8 of page 2 of Applicant's specification, also see "known" in line 8 of page 2 of Applicant's specification).

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadi H. Dahbour whose telephone number is 703-306-5479. The examiner can normally be reached on M-F, 9am-5:30pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Art Unit: 3742

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

  
Teresa Walberg  
Supervisory Patent Examiner  
Group 3700

Fadi H. Dahbour  
Examiner  
Art Unit 3742

April 17, 2003